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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,916	01/31/2001	Jacob Nellemann	0459-0546P	1113

2292 7590 06/29/2004

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EXAMINER

PHAM, THOMAS K

ART UNIT	PAPER NUMBER
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2121

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,916

Applicant(s)

NELLEMANN ET AL.

Examiner

Thomas K Pham

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

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Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05/14/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2121

First Action on the Merits

1. Claims 1-17 of U.S. Application 09/772,916 filed on 1/31/2001 are presented for examination.

Quotations of U.S. Code Title 35

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2121

Claim Rejections - 35 USC § 102

6. Claims 1-3, 5-13 and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,009,459 ("Belfiore").

Regarding claims 1 and 11

Belfiore teaches identifying desired information in a network, said method comprising:

- a. providing a network holding or representing information at a plurality of addresses (abstract),
- b. providing a URL, said URL being expected to be associated with a desired document in the network at which desired information is expected to be represented (col. 4 lines 35-37, "identifies many such instances ... to the desired web site"),
- c. performing a first search so as to locate the desired document using the provided URL (col. 3 lines 63-67, "an Address box in which ... a proper URL by applying heuristics"), and
- d. automatically performing a second search using at least part of the provided URL in order to generate one or more URL's, each of said one or more URL's being associated with a document in the network (col. 3 line 67 to col. 4 line 7, "When the system determines ... search by the search engine").

Regarding claims 2 and 12

Belfiore teaches displaying the generated URL's if the desired document is not located (col. 4 lines 13-15, "When search results ... user interface element").

Regarding claims 3 and 13

Belfiore teaches selecting at least one of the generated one or more URL's (col. 4 lines 16-18,

Art Unit: 2121

“the search results ... in the search results”).

Regarding claims 5 and 15

Belfiore teaches the first and second search is performed sequentially (col. 4 lines 19-22, “the passing of search ... a certain time frame”).

Regarding claims 6 and 16

Belfiore teaches the network forms part of the Internet (abstract).

Regarding claims 7 and 17

Belfiore teaches the desired document comprises a web page (col. 4 lines 35-37, “identifies many such instances ... to the desired web site”).

Regarding claim 8

Belfiore teaches the URL is provided using an Internet browser (abstract).

Regarding claim 9

Belfiore teaches the network comprises a client machine, a service provider and a server containing a searchable database (col. 4 lines 41-45, “a computing environment 28 ... via Internet connection 32”).

Regarding claim 10

Belfiore teaches the client machine initiates the first and second search (col. 6 lines 8-29, “Users may enter directive ... readied for the Autosearch”).

Claim Rejections - 35 USC § 103

7. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belfiore in view of U.S. Patent No. 6,560,634 (“Broadhurst”).

Art Unit: 2121

Regarding claims 4 and 14

Belfiore teaches a system for identifying desired information in a network but does not teach the first and second search is performed essentially simultaneously. However, Broadhurst teaches an improve query server which performs multiple of searches simultaneously (col. 2 lines 34-37, "an improved query server ... transparent to the user") for the purpose of eliminating the need for a user to perform individual searches. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the query server of Broadhurst with the system of Belfiore because it would provide for the purpose of eliminating the need for a user to perform individual searches.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thomas Pham*; whose telephone number is (703) 305-7587 and fax number is (703) 746-8874, Monday-Thursday and every other Friday from 7:30AM- 5:00PM EST or contact Supervisor *Mr. Anthony Knight* at (703) 308-3179.

Any response to this office action should be mailed to: **Director of Patents and Trademarks Washington, D.C. 20231**, or **Hand-delivered** responses should be brought to **Crystal Park II, 2121 Crystal Drive Arlington, Virginia, (Receptionist located on the 4th floor)**, or fax to the **official fax number (703) 872- 9306**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Thomas Pham
Patent Examiner

TP

June 24, 2004


Anthony Knight
Supervisory Patent Examiner
Group 3600